

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Group 1617

Maria da Graça Henriques Vicente *et al.*

Examiner Chong, Yong Soo

Serial No. 10/712,228

Confirmation No. 8492

Filing Date: November 12, 2003

For: Treating and Preventing Viral Infections with Porphyrin-Based Compounds
(File Vicente 0210.1)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This paper is submitted in response to the March 30, 2007 restriction requirement.

No amendments are presented.

A fee of \$60 for a one-month extension of time is being paid online as a small entity, to extend the time for response from April 30, 2007 to May 30, 2007. If this amount is incorrect, please refer to the Deposit Account Authorization previously filed for this application. If any additional extension of time is required, please consider this paper a petition for the total extension of time required. See 37 C.F.R. § 1.136(a)(3).

Applicants respectfully traverse the restriction requirement, for the reasons given below.

Provisional Election

In response to the restriction requirement, Applicants provisionally elect with traverse Group I, which the Office identified as including Claims 1-23.

Election of Species

In response to the election of species requirement, Applicants elect the following species for initial examination:

A method for inhibiting or preventing human immunodeficiency virus infection in a human patient, or for killing or inhibiting human immunodeficiency virus on a material; said method comprising administering to the patient an effective amount of Compound **33**, or treating the material with an effective amount of Compound **33**.

Claims 1-5, 7-9, 12-16, 18-20, and 23 read on the elected species.

Traversal of Restriction Requirement

It is respectfully submitted that what the March 30, 2007 Office Action identified as a restriction requirement would more properly be an election of species requirement. If the Office were to modify the restriction requirement to instead become an election of species requirement (without other significant change) then Applicants would withdraw their traversal of the restriction requirement.

Applicants' above response to the original election of species requirement should also be responsive to the proposed new election of species requirement (again, assuming there are no other significant changes).

The restriction requirement should be withdrawn for either of two alternative reasons. Either reason alone suffices to show that the restriction requirement is improper:

A claim may not ordinarily be restricted from itself.

The manner in which the Office grouped the Claims demonstrates that restriction is improper, even without conducting a detailed analysis of the substance of the Claims.

All pending Claims, with two exceptions, were placed into both Groups.

Claim 1 was placed into both Group I and Group II.

Claim 2 was placed into both Group I and Group II.

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And likewise, for all other pending Claims -- except that Claims 3 and 14 were placed into Group I only.

Restriction may not ordinarily be required within a single claim. See M.P.E.P. § 803.02. The second and third paragraphs of M.P.E.P. § 803.02 provide in part (citations omitted):

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species. . . .

[I]t is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

"Unity of invention" under M.P.E.P. § 803.02 clearly exists. The defined compounds share a common utility, namely, antiviral activity; and they share a substantial structural feature essential to that utility, namely, a "porphyrin macrocycle, and . . . one or more carboranyl groups that are linked to the porphyrin macrocycle by carbon-carbon bonding."

Restriction may not ordinarily be required within a Claim. For this reason alone, the restriction requirement should be withdrawn.

The two groups are not “independent” within the contemplation of M.P.E.P. Chapter 800.

The Office asserted that “Inventions I and II are unrelated,” relying on M.P.E.P. §§ 806.04 and 808.01. March 30, 2007 Restriction Requirement, p. 2.

It is respectfully submitted, however, that these two groups are closely related. They are not “independent,” as that term is used in Chapter 800 of the M.P.E.P.: “The term ‘independent’ (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation and effect.” M.P.E.P. § 802.01, subpart (I). “Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions and different effects are independent. An article of apparel and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.” M.P.E.P. § 806.06, subpart (A). This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

The present application is not one of the rare exceptions. Groups I and II are, in fact, closely related. The same class of compounds is used for the same purpose, inhibiting viruses. The two groups are capable of use together, viz., to inhibit different types of viruses simultaneously with the same compound or with closely related compounds. They have a similar mode of operation, being chemically the same or closely related. They have the same function, to inhibit viruses. And they have the same effect, inhibiting viruses.

The two groups identified by the Office are related, and may not properly be restricted from one another on the ground that they are “unrelated.” For this reason alone, the restriction requirement should be withdrawn.

Summary

For either of the two alternative reasons given, it is respectfully submitted that the restriction requirement should be withdrawn: **(1)** It is improper to restrict a Claim against itself. **(2)** The two Groups are related, they are not “independent.”

Miscellaneous

For the record, Applicants do not agree with a statement appearing in the next-to-last paragraph on page 3 of the March 30, 2007 restriction requirement: “Note the court in *In re Herrick et al.* and *In re Joyce et al.* (both at 115 USPQ 412) held that an election of species requirement, was, in fact, a restriction requirement.”

This statement may have just been made in passing, and may not have been intended as being of any consequence. For the record, Applicants respectfully note that, while some similarities do exist, the M.P.E.P. also draws significant distinctions between a restriction requirement and an election of species requirement. For example, see form paragraphs 8.01 and 8.02, which are quoted in M.P.E.P. § 809.02(a), “Election of Species Required.” Each of these form paragraphs provides in part:

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Similarly, see 37 C.F.R. § 1.141(a). Note particularly that the provisions concerning allowance of a generic claim following an election of species do not depend upon whether the original election was made with or without traverse. In either case, upon the allowance of a generic claim, the applicant is entitled to consideration of claims to additional species.